

REMARKS

The present application was filed on September 26, 2003 with claims 1 through 25. Claims 1, 2, 4-14, and 16-25 are presently pending in the above-identified patent application. The present response proposes to amend claims 1, 13 and 15, and to cancel claims 8-10 and 20-22, without prejudice. This amendment after final rejection is submitted with a Request for Continued Examination (RCE) and should be entered.

The Examiner is thanked for the courtesy of a telephone interview on May 15, 2008 in which the present amendments were discussed. The Examiner agreed that the present amendments distinguished the claims over the cited references.

In the Office Action, the Examiner rejected claims 1, 2, 4-12 and 25 under 35 U.S.C. §102(e) as being anticipated by Richman (United States Publication No. 2004/0266363), rejected 13-14 and 16-24 under 35 U.S.C. §103(a) as being unpatentable over Schmidt (United States Publication No. 2002/0196029) in view of Cheung et al. (United States Patent No. 6,577,157).

Independent Claims 1, 13 and 25

Independent claims 1, 13, and 25 were rejected 35 U.S.C. §102(e) as being anticipated by Richman. Independent claims 1, 13, and 25 are directed towards wireless communications between an integrated circuit device and *a monitoring station*. Richman, however, teaches communications between two integrated circuits within an enclosure.

Each independent claim has been amended to emphasize the limitations of claims 8-10 (by reciting that the “monitoring station performs one or more of testing, debugging and evaluating said integrated circuit”). The Examiner has previously considered these limitations in rejecting claims 8-10. When rejecting claims 8-10, the Examiner relied on pars. [0012] and [0013]. These paragraphs, however, merely note that the enclosure 150 may be the housing of a self-contained device normally sold as a single unit, such as a computer, digital television, peripheral, network router, OEM product or sub-assembly.

There is no disclosure or suggestion in this passage or elsewhere in Richman that

the monitoring station “performs one or more of testing, debugging and evaluating said integrated circuit”. Thus, Richman cannot be said to anticipate the present invention under Section 102. During the telephone interview, the Examiner indicated agreement on this point.

In addition, Richman and the present application are each assigned of record to Agere Systems Inc. See, Reel/Frame 014537/0165 and 014553/0640, respectively. Richman qualifies as prior art only under Section 102(e). Thus, pursuant to Section 103(c)(1), Richman is not available as prior art under Section 103 (subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person).

Thus, Applicant respectfully requests withdrawal of the Section 102 rejection.

Dependent Claims 2, 4-12 and 14-24

Dependent claims 2, 4-7, 11-12 and 14-15 were rejected under 35 U.S.C. §102(e) as being anticipated by Richman. Claims 2, 4-7, 11-12 and 14-15 are dependent on claims 1 and 13, respectively, and are therefore patentably distinguished over Richman, because of their dependency from amended independent claims 1 and 13 for the reasons set forth above, as well as other elements these claims add in combination to their base claim.

All of the pending claims, i.e., claims 1, 2, 4-7, 11-14, 16-19 and 23-25, are in condition for allowance and such favorable action is earnestly solicited.

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Examiner is invited to contact the undersigned at the telephone number indicated below.

The Examiner's attention to this matter is appreciated.

Respectfully submitted,



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